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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,816	03/22/2001	Alejandro Wiechers	10003930-1	6165

7590	03/27/2007
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EXAMINER	
HUTTON JR, WILLIAM D	

ART UNIT	PAPER NUMBER
2176	

MAIL DATE	DELIVERY MODE
03/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

Acknowledgment of Reply Brief

The reply brief filed 01/29/2007 has been entered and considered. The application has been forwarded to the Board of Patent Appeals and Interferences for decision on the appeal.

Response to Reply Brief

Appellant's arguments filed in the Reply Brief dated 01/29/2007 have been fully considered but they are not persuasive.

Sturgeon does not teach determining if a page is properly "aligned" when that term is properly construed in light of the Specification:

Appellant argues that Sturgeon fails to teach determining if a page is properly aligned because the term "aligned," when read in light of the Specification, refers to how the page is positioned on the scanner. Appellant quotes two passages from the Specification of the present invention. Based on the emphasized text in the quoted passages, Appellant appears to argue that the recited term "aligned" should be interpreted to mean that the computer software determines if the scanned page was properly aligned for scanning with respect to the scanner (emphasis added). In other words, Appellant argues that the disputed limitation should be interpreted to mean that the recited "determination" is based on whether the scanned page is properly positioned relative to the scanner (emphasis added). See Reply Brief – Pages 1-2.

The examiner disagrees.

Firstly, the examiner notes that the feature upon which Appellant relies (*i.e.*, determining if the scanned page was properly aligned for scanning with respect to the scanner) is not recited in the rejected claims. None of the rejected claims recite that the determination of whether the scanned page was properly aligned is based upon the scanned page's position with respect to the scanner. Limitations appearing in the Specification but not recited in the claim should not be read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily). *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). See also *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

Secondly, as explained in detail in the *Examiner's Answer*, the Specification of the present invention does not limit the disputed claim language to a "proper alignment" of the scanned page with respect to the scanner (see *Examiner's Answer* → Pages 28-36). At the time the present invention was made, one of ordinary skill in the art included a computer programmer who writes code for document scanning systems. If this person were to have read the Specification of the present invention and the claims of the present application as they are currently recited, he/she would have come to the conclusion that the expressly recited limitation (*i.e.*, "*determining if the scanned page*

was properly aligned for scanning") includes scanned pages that are out of order, upside-down and missing (see the rationale discussed in the *Examiner's Answer* → Pages 32-35).

Thirdly, in response to Appellant's remarks that missing and out-of-sequence page determinations are explicitly distinguished from alignment in the Specification and in the claims (see *Reply Brief* – Page 2, last paragraph), the examiner notes that, when one of ordinary skill in the art reads the Specification as a whole, he/she realizes that determining whether a scanned page was "properly aligned" and determining whether a scanned page was "properly registered" is the same thing. In other words, upon a full and careful reading of the Specification, one of ordinary skill in the art would have realized that there is no difference between a scanned page being "properly aligned" and "properly registered." For example, see the Specification of the present application at Page 9, Lines 6-20 (which discusses reviewing a scanned page based on the user-selected registration characteristic and designating those scanned pages that are not properly registered, like missing pages and out-of-order pages) and at Page 4, Lines 7-8 (which describes Figure 6 as showing an "improperly registered" scanned page).

Fourthly, as explained in the *Examiner's Answer*, the (see Page 36, first full paragraph), even if limitations are read from the Specification and placed into the claims, Sturgeon still discloses *determining if the scanned page was properly aligned for scanning with respect to the scanner*.

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Fifthly, if Appellant is basing the patentability of the present claims on detecting misalignment of the scanned page with respect to the scanner, then the examiner points out that Appellant should know that the prior art is replete with detecting such misalignment, as demonstrated in both Sturgeon (see Column 6, Lines 35-37) and Rangarajan, US Patent No. 5,822,454 included in Appellant's IDS dated 08/02/2004 (see Column 1, Lines 9-12).

WDH
March 19, 2007

A handwritten signature in black ink, appearing to read 'D. Hutton', with a stylized flourish at the end.

Doug Hutton
Primary Examiner
Technology Center 2100